

DOCKET NO. WILK03-00004
Customer No. 23990



AF
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Angela Marcela Wilkinson
Serial No. : 10/055,358
Filed : January 22, 2002
For : PLACEMAT WITH CONFORMAL INTEGRAL DRINK
COASTER
Group No. : 1772
Examiner : A.S. Thomas

MAIL STOP APPEAL BRIEFS – PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY BRIEF

This Reply Brief is submitted on behalf of Appellant for the application identified above.

Please charge any necessary fees to Deposit Account No. 50-0208.

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1. The rejection over *Kaye* does NOT make clear that Applicant's teachings are being relied upon.

The Examiner's Answer attempts to enter a modify the grounds of rejection based on *Kaye*. While admitting that the rejection did NOT state it was based on *Kaye* "in view of applicant's acknowledged state of the art,"¹ the Examiner's Answer asserts that "it is clear from the body of the rejection that applicant's acknowledge state of the art was being relied upon as a secondary reference." Examiner's Answer, page 3. However, the "secondary reference" cited is NOT specified in the final rejection.

Applicant merely notes this discrepancy as probative of the quality of work conducted by the Examiner and the conferees. Examination of the present application has not been characterized by thoughtful reasoning during a meticulous review, but instead reflects minimal work aimed at justifying a predetermined conclusion. The credibility of the Examiner and the conferees in concluded that various claim features are either implicit in the prior art or obvious modifications thereof should be judged accordingly.

2. There is no evidence to support the desirability of the proposed modification.

The Examiner's Answer states:

[I]t is the Examiner's position that adjusting the size of the placemat and its extensions is well within the purview of one of ordinary skill in the art to achieve the desired coverage or protection for a particular use.

¹ The Examiner's Answer characterizes the absence of such phrase as "inadvertent."

Examiner's Answer, page 4. This statement fails to identify a motivation for making the proposed modification other than the desirability—seen from the vantage of hindsight—of the result once the modification is made. Moreover the desired result is adopted from Applicant's specification and claims. Still further, the fact that a modification is within the “purview” or ability of an ordinary artisan is not sufficient to establish a *prima facie* case of obviousness.

3. There is no evidence to suggest that the placemats depicted in the cited references are reversible.

The Examiner's Answer asserts in conclusory fashion that the placemats depicted in *Kaye* and *Kamel et al* may be used while resting on either of two opposing surfaces. No evidence is cited supporting this conclusion, nor do the references support this inference. The construction of the placemats shown is not specified, such that it cannot be determined (for instance), whether one side of the placemat in *Kaye* is laminated while the other side is exposed paper that would be ruined by exposure to moisture and/or heat, or whether the bottom side of *Kamel et al* is corrugated or contains other raised structures (e.g., a raised perimeter and other supporting framework) rendering the placemat unsuitable for use on the opposite side.


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The cited references fail to teach or suggest every feature recited in the claims. Therefore, the rejection under 35 U.S.C. § 103 is improper. Applicant respectfully requests that the Board of Appeals reverse the decision of the Examiner below rejecting pending claims 1-2, 4-5 and 9-20 in this application.

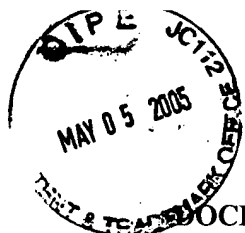
Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 4-25-05


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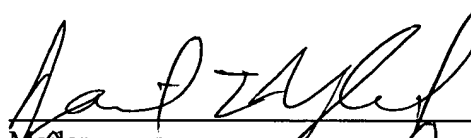
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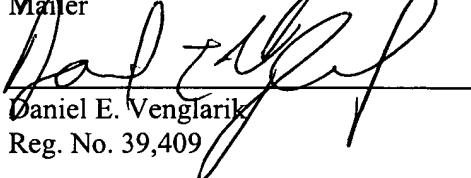
1. Reply Brief; and
2. A postcard receipt;

relating to the above application, were deposited as "First Class Mail" with the United States Postal Service, addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 25, 2005.

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